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09/581,397 10/02/00 SUNDSTROM

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EXAMINER

LUKTON, D

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

06/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/581,397

Applicant(s)
Sundstr m

Examiner
David Lukton

Art Unit
1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on May 21, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above, claim(s) 3, 4, 7, and 9-18 is/are withdrawn from consideration.

5) ☒ Claim(s) 1, 2, 5, 6, and 8 is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

Applicants' election of Group I (claims 1-16) with traverse is acknowledged. Also acknowledged is the elected specie, which is the compound of claim 8.

Claims 17-18 are withdrawn from consideration, pursuant to the restriction. In addition, claims 3, 4, 7, 9-16 are withdrawn from consideration, since they do not encompass the elected specie. Claims 1, 2, 5, 6 and 8 are examined in this Office action.

*

Claims 1, 2, 5, 6 and 8 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 recites the term "substantially pure" in reference to a compound of formula I. This is entirely unnecessary and undesirable when a structural formula is given. The phrase may be appropriate in cases where a compound has been isolated from a plant or animal, and where the compound has been only partially purified, and partially characterized. But such is not the case here. Applicants should delete the term at issue ("substantially pure").
- In claim 1, line 1, the term "general" is superfluous and unnecessary.
- Claim 1 recites that either of "X" and "Y" can be "a simple heteroatom-containing group". What is meant by this? Is any moiety included as long as it contains at least one atom of nitrogen, sulfur, oxygen selenium, boron or arsenic? It would help to advance the discussion if applicants were to provide a few examples. One question here is, what are the limits... for example, if "X" or "Y" were a small peptide, would that be included?
- Claim 2 recites (first line) "compounds" in the plural. However, the singular should be used, since it is used in claim 1. The same applies in claims 5 and 6.

- The rationale for the dependence of claim 8 on claim 1 is not clear. Claim 1 does not permit "Q" to be a guanidino group, which is what is present in claim 8. Claim 1 does permit "Q" to be a group of the formula X(Y)N-, but there is no indication that either "X" or "Y" can be an amidino group. Accordingly, an explanation is sought; alternatively, claim 8 can be made independent.

*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 6 and 8 are rejected under 35 U.S.C. §102(b) as being anticipated by Cherskey (WO 93/12777).

Cherskey teaches (p. 14, line 16+) a compound designated "R". This is identical to the compound in claim 8 (the elected specie).

Thus, the claims are anticipated.

Syner p 22, 30
p 31, 20

*

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Cherskey (USP ~~5,424,947~~). 5,242,947

Cherskey teaches (cols 7-8, approximately line 50) compound "B"

Thus the claim is anticipated.

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Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Cherskey (USP 5,424,202).

Cherskey teaches (cols 11-12), generic formula I. This overlaps that of claim 1.

Thus, the claim is anticipated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800